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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/061,675
Filing Date: February 01, 2002
Appellant(s): NORMAN, JAMES G.

Matthew J. Himich
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 03 December 2007 appealing from the Office action mailed 03 May 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

4971362	LAPSKER	11-1990
5935060	ILIFF	08-1999
5953704	MCILROY	09-1999
6738754	NORMAN JR.	10-1999

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 8, 15-18, 20-30 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-8, 12-15, 19-23 of prior U.S. Patent No. 6738754. This is a double patenting rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-5 and 11-13 rejected under 35 U.S.C. 103(a) as being unpatentable over Lapsker (4,971,362) in view of Illiff (5,935,060).

4. As per claim 1, Lapsker teaches a method of using a prescription pad to facilitate providing health care information to a patient, the prescription pad having a plurality of prescription sheets (Lapsker; Abstract), the method comprising:

Performing a diagnostic procedure on a patient to identify an ailment of the patient (Lapsker; Col. 1, lines 12-20); Examiner respectfully submits that one of ordinary skill in the art would understand a physician to examine a patient before writing a prescription.

Giving the one prescription sheet to the patient (Lapsker; Col. 1, lines 12-20).

Lapsker teaches a preprinted prescription form with various information to help dispense a pharmaceutical product (Lapsker; Col. 4, lines 56-50). Lapsker does not expressly teach placing on at least one of the prescription sheets of the prescription pad an address for an Internet web site, information about the ailment being accessible via the Internet web site. However this is well known in the art as evidenced by Iliff. In particular Iliff does teach using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). It would have been obvious to add the Internet feature of Iliff to the prescription pad taught by Lapsker with the motivation of personalizing the prescription form for use by a physician (Lapsker; Col. 4, lines 30-34) and provide an automated way of providing a patient medical advice and diagnosis that is quick, efficient, and accurate (Iliff; col. 1, lines 54-59).

5. As per claim 2, Lapsker teaches wherein the step of placing the address for the Internet web site on at least one of the prescription sheets precedes the step of performing the diagnostic procedure on the patient (Lapsker, lines 38-44). Examiner interprets "preprinted" to be printed prior to any examination by the physician.

6. As per claim 3, Lapsker teaches wherein the prescription pad is preprinted with a listing of a plurality of ailments (Lapsker; Col. 5, lines 8-11).

Lapsker does not expressly teach wherein the method further comprises instructing the patient to initiate a search via the Internet web site about one of the plurality of listed ailments. However, this is well known in the art as evidenced by Iliff. In particular Iliff does teach providing a database of diseases, symptoms, treatments, and medications for medical diagnosis and advice (Iliff; Col. 3, lines 58-61). It would have been obvious to add this feature to the Lapsker method with the motivation of

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providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59).

7. As per claim 4, Lapsker teaches wherein the prescription pad is preprinted with a listing of names of a plurality of ailments (Lapsker; Col. 5, lines 8-11).

Lapsker does not expressly teach wherein the Internet website is adapted to retrieve information about any one of the plurality of ailments upon initiation of a signal associated with said any one of the plurality of ailments, and wherein the method further comprises instructing the patient to perform an action which initiates via the web site a signal associated with one of the plurality of listed ailments in a manner to retrieve information about said one of the plurality of listed ailments. However, this is well known in the art as evidenced by Iliff. The reasons for rejection from claim 3 are incorporated herein.

8. As per claim 5, Lapsker does not expressly teach wherein the step of instructing the patient to perform an action comprises instructing the patient to input into a computer communicating with the web site the name of said one of the plurality of listed ailments. However, this is well known in the art as evidenced by Iliff. It would have been obvious to add this feature to the Lapsker method with the motivation of providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59).

9. As per claim 11, Lapsker teaches furnishing prescription pads to health care providers, each of the prescription pads including a plurality of prescription sheets, the prescription sheets having placed thereon an address (Lapsker; Col. 4, lines 30-35). Lapsker does not expressly teach storing descriptive information about a plurality of ailments in a computer database nor does it teach providing a retrieval system accessible by an Internet user using the Internet, the retrieval system being adapted to retrieve the stored descriptive information for an ailment of the plurality of ailments upon

the user initiating a signal corresponding to the ailment. However this is well known in the art as evidenced by Iliff. In particular Iliff does teach providing a database of diseases, symptoms, treatments, and medications for medical diagnosis and advice (Iliff; Col. 3, lines 58-61). Iliff also teaches using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). It would have been obvious to add these features to the Lapsker method with the motivation of providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59). Furthermore it would have been obvious to one of ordinary skill in the art to add an address of an Internet website to the prescription pad taught by Lapsker with the motivation of personalizing the use by a physician (Lapsker; Col. 4, lines 33-34).

10. As per claim 12, Lapsker does not expressly teach wherein the descriptive information for each ailment comprises one or more of the following: physiological aspects of the ailment, pathological aspects of the ailment, information as to whether the ailment is treatable, information about expected clinical course, and potential complications. However this is well known in the art as evidenced by Iliff. In particular Iliff does teach providing a database of diseases, symptoms, treatments, and medications for medical diagnosis and advice (Iliff; Col. 3, lines 58-61). Iliff also teaches using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). It would have been obvious to add these features to the Lapsker method with the motivation of providing patient medical advice and diagnosis that is quick, efficient and accurate (Iliff; col. 1, lines 54-59).

11. Claim 13 repeats the limitations recited in claim 1 and the reasons for rejection are incorporated herein.

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12. Claims 6-10, 14, 15-16, 20-24 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lapsker (4,971,362) in view of Illiff (5,935,060) and McIlroy (5,953,704).

13. As per claim 6, Lapsker does not expressly teach wherein the step of instructing the patient to perform an action comprises instructing the patient to input into a computer communicating with the web site an ICD or CPT code associated with said one of the plurality of listed ailments. However, these features are well known in the art as evidenced by Illiff and McIlroy. In particular Illiff teaches using the Internet as a connection for a diagnostic system (Illiff; Col. 4, line 3). It would have been obvious to add the Internet feature of Illiff to the prescription pad taught by Lapsker with the motivation of providing an automated way of providing a patient medical advice and diagnosis that is quick, efficient, and accurate (Illiff; col. 1, lines 54-59). McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

14. As per claim 7, Lapsker does not expressly further comprising instructing the patient to input into a computer communicating with the web site an ICD or CPT code associated with the ailment of which the patient was diagnosed as having, wherein the Internet web site and computer are configured in such a manner that the input of the ICD or CPT code results in retrieval via the Internet web site of information about the ailment. However, these features are well known in the art as evidenced by Illiff and McIlroy. In particular Illiff teaches using the Internet as a connection for a diagnostic system (Illiff; Col. 4, line 3). It would have been obvious to add the Internet feature of Illiff to the prescription pad taught by Lapsker with the motivation of providing an automated

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way of providing a patient medical advice and diagnosis that is quick, efficient, and accurate (Iliff; col. 1, lines 54-59). McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

15. Claims 8 and 9 repeat the limitations recited in claim 1 and 6 and the reasons for rejection are incorporated herein.

16. Claim 10 repeats the limitations of claim 2 and the reasons for rejection are incorporated herein.

17. As per claim 14, Lapsker does not expressly teach wherein the descriptive information about each of the plurality of ailments is associated with at least one ICD or CPT code for said each of the plurality of ailments, wherein the retrieval system is adapted to retrieve the stored descriptive information for an ailment of the plurality of ailments upon the user initiating a signal corresponding to the at least one ICD or CPT code for the ailment. However these features are will known in the art as evidenced by McIlroy. In particular, McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

Lapsker also does not expressly teach directing the health care providers to write on the prescription sheets the ICD or CPT codes associated with the diagnosed ailments. However this is well known in the art as evidenced by McIlroy. Lapsker does the preprinted prescription containing information required to dispense the pharmaceutical product (Lapsker; Col. 4, lines 46-50). McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

18. Claim 15 repeats the limitations of claim 6 and the reasons for rejection are incorporated herein.

19. Claim 16 repeats the limitations of claim 12 and the reasons for rejection are incorporated herein.

20. Claim 19 repeats the limitations of claims 1 and 6 and the reasons for rejection are incorporated herein.

21. Claims 20-24 repeat the limitations of claims 6 and 7 and the reasons for rejection are incorporated herein.

22. Claims 17-18, and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Illiff (5,935,060) in view of McIlroy (5,953,704).

23. As per claim 17, Iliff teaches an Internet navigational system for providing health care information to a user comprising (Iliff; Abstract):

a retrieval system accessible by an Internet user using the Internet, the retrieval system being adapted to retrieve the stored descriptive information corresponding to one of the ailments upon the user initiating a signal (Iliff; Col. 3, lines 58-61 and Col. 4, line3).

Iliff does not expressly teach: a computer database having stored therein descriptive information about a plurality of ailments, each ailment being associated with at least one ICD or CPT code; and the signal corresponding to the at least one ICD or CPT code associated with such ailment.

However these features are well known in the art as evidenced by McIlroy. In particular, McIlroy teaches entering an ICD code to pull up various guidelines associated with a diagnosis code (McIlroy; Col. 11, lines 5-15). It would have been obvious to add this feature to Lapsker with the motivation of providing a health care management data processing system that is real-time and interactive and also allow others in the health care field to promote cost-effective health care (McIlroy; Col. 2, lines 55-61).

24. As per claim 18, Iliff teaches wherein the descriptive information stored in the computer database comprises one or more of the following: physiological aspects of the ailment, pathological aspects of the ailment, information as to whether the ailment is treatable, information about expected clinical course, and potential complications (Iliff; Col. 3, lines 58-61).

25. Claims 25 and 26 repeats the limitations of claim 17 and the reasons for rejection are incorporated herein.

26. Claims 27 and 28 repeat the limitations of claim 17 and the reasons for rejection are incorporated herein.

Claims 29 and 30 repeat the limitations of claims 17 and 18 and the reasons for rejection are incorporated herein.

(10) Response to Argument

In the Appeal Brief filed 03 December 2007, Appellant makes the following arguments:

A) Claim 8 is *not* unpatentable under Double Patenting in view of claims 1-8, 12-15 and 19-23 of Norman, Jr. (6,738,754).

B) Claims 1-5, 11-13 are *not* obvious under 35 USC 103(a) as being unpatentable over Lapsker (4,971,362) in view of Iliff (5,935,060).

C) Claims 6-10, 14, and 19 are *not* obvious under 35 USC 103(a) as being unpatentable over Lapsker in view of Iliff and McIlroy (5,953,704).

The Examiner will address the arguments in the order that they appear in the Appeal Brief.

Argument A:

Claims 8, 15-18, 20-30 are unpatentable under 35 USC 101 as claiming the same invention of US Patent No 6738754 claims 1-8, 12-15, 19-23 as clearly stated on

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pf. 2 of the 5/3/07 Office Action. Claims 1-8 of 6,6738,754 clearly teach a method of directing a patient to a source of health care information comprising ascertaining ICD or CPT codes and inputting the codes to retrieve information. This is the same invention that Appellant is attempting to claim in claims 8, 15-18, and 20-30.

Argument B:

In response to the argument that claims 1-5 and 11-13 are not obvious over Lapsker in view of Iliff. Examiner disagrees.

In response to appellant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Appellant on pg. 10 of the Appeal Brief argues that Lapsker has nothing to do with providing information to a patient. Examiner disagrees. It is true that one embodiment of Lapsker teaches a pad used by physicians, pharmacists and drug manufacturers to control and track medication rebates, reimbursements and vouchers. However, the Lapsker pad is clearly not limited to this use. Lapsker teaches a "first sheet member" with a zone for entering in prescription information (Lapsker; Col. 3, lines 15-25). The "second sheet member" is used to obtain reimbursements but the "first sheet member" is given to the patient to obtain the prescription.

Iliff is incorporated with Lapsker for its teachings that using the Internet to obtain medical information was old and well known in the art. Iliff teaches using the Internet as a connection for a diagnostic system (Iliff; Col. 4, line 3). Appellant on pg. 11 of the Appeal Brief focuses on Iliff being a computerized knowledge-based medical diagnostic system and has nothing to do with a prescription pad. Examiner agrees that Iliff does not teach a prescription pad, but contends that use of the Internet to obtain medical information in conjunction with the Lapsker teachings reads upon claim 1. Appellant, himself, says on pg. 10 of the Appeal Brief that Claim 1 teaches enabling the user to access information on an Internet website about his or her ailment. Iliff is directed to this same subject matter.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, there is sufficient motivation to combine the teachings of Iliff with Lapsker. Examiner believes providing an automated way of providing medical advice that is quick, efficient and accurate (Iliff; col. 1, lines 54-59) is a sufficient motivation to combine the teachings of Lapsker and Iliff. Applicant on pg. 12 of the Appeal Brief argues that going to the Internet to re-

diagnose a condition would be inefficient. However, Examiner contends that using the Internet feature of Iliff would be more efficient than having to go to another physician to get another opinion.

In addition, as discussed in the *KSR International Co. v. Teleflex Inc. et al.*, 127 S.Ct 1727 (2007), "[o]ften, it will be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. To facilitate review, this analysis should be made explicit. See *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) ('[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'). As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ" (emphasis added). The claimed invention of placing an Internet address on a prescription pad is merely a combination of old elements as taught by Lapsker in view of Iliff.

Finally, Examiner points out that the placing of an "address for an Internet website" is directed to non-functional descriptive matter. The information placed on the prescription pad is just data and is given little to no patentable weight as no requisite functionality is imparted by the data printed on the pad

Argument C:

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In the final argument, Appellant is also attacking the references individually where the rejection was made based on a combination of references.

McIlroy is applied for the teaching that pulling up medical information using ICD or CPT codes was old and well known in the art (McIlroy; Col. 11, lines 5-15). Thus, at the time of Appellant's claimed invention the use of ICD codes to obtain more information regarding an ailment as taught by McIlroy was within the level of ordinary skill. As discussed above there was sufficient motivation to incorporate this feature with ICD to provide quick, efficient and accurate medical advice. One of ordinary skill would

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recognize that using the Internet and ICD codes to pull up information would be more efficient than having to do so manually through books or papers.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/M. L./

Examiner, Art Unit 3626

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